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| 09/894,108 | 06/28/2001 | Dwip N. Banerjee | AUS920010309US1 | 6271 |

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| EXAMINER |
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DENNISON, JERRY B

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| ART UNIT | PAPER NUMBER |
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2143

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,108

Applicant(s)

BANERJEE ET AL.

Examiner

J. Bret Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,11-19,21-40 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-19,21-40 and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Application Number 09/894,108 received on 4/12/2006.
2. Claims 1-7, 9, 11-19, 21-40, and 42-48 are presented for examination.

Response to Arguments

Examiner appreciates Applicant's explanation of the term "gradually" in reference to the Specification, mainly page 2, lines 28-30, page 3, lines 1-4, 8-15. The previous 112 rejection has been withdrawn. Examiner will interpret the term "gradually" in light of the specification, with reference to "reduce but not terminate, the level of service", "which may include decreasing the content available to a subscriber, downloading the subscription content at a slower than normal rate, delivering certain features in black and white instead of color, deleting sound files that are delivered in the full level of service subscription, disabling any inter-active features,..., or any combination of these features" as cited by Applicant.

The independent claims have been amended to incorporate the features of previous claim 10. Applicant provides arguments mainly towards Examiner's Official Notice taken in the previous Office Action. Examiner maintains the rejection based on Drosset and Nye for the following reasons:

Applicant's arguments include the failure of previously applied art to disclose, "providing a reduced level of service 'during a post-expiration period'" and "terminating

the access 'unless the subscription is renewed'" [see Applicant's Response, page 13, paragraph 3, page 14, paragraph 1].

Applicant also argues that "Drosset's disclosure of downgrading access on expiration due to nonpayment teaches away from terminating access after expiration, as set out in examiner's Official Notice" [see Applicant's Response, page 14, paragraph 3, page 14, paragraph 1].

Examiner respectfully disagrees.

Drosset disclosed that user's may downgrade from paying to non-paying membership (Drosset, col. 15, lines 47-50). As Examiner stated in the previous Office Action, Drosset did not explicitly state terminating subscriber access to the online subscription service after a specified post expiration period as the independent claims now include. However, Drosset does in fact state that the user's information may be preserved for a period of time in the expectation that the account may be once again upgraded (Drosset, col. 15, lines 53-57). Therefore, Drosset disclosed that over a certain period of time, the status of data may transition into another category, and that data may be dropped. Drosset did not explicitly state a termination category for subscriptions. However, as explicitly shown by Nye, after a certain period of time has elapsed, and the user has not renewed their subscription, the subscription is placed into a canceled subscriptions category (Nye, page 4, ¶ 46). Nye disclosed that "over time the status of the data that resides in one category transitions to another category, known as a state transition...For example the data held in the free trial subscribers

category is moved to the canceled subscriptions category when a person lets their subscription run out..." Therefore, Nye showed that the state transition for subscriptions to be terminated was well known.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 11-15, 33, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset.

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3. Regarding claim 1, Drosset disclosed a method and system for a subscriber based service over a communication network in which users are set up with a payment schedule by credit card (Drosset, col. 15, lines 19-20), where the website submits a request to debit the account by the schedule chosen (Drosset, col. 15, lines 27-29) and the account may be downgraded to nonpaying membership through invalidation of the payment information i.e. expired or invalid credit card (Drosset, col. 15, lines 47-51) and the user is denied the privileges afforded to paying users (Drosset, col. 15, lines 51-52).

Therefore, regarding claims 1, 33, and 48, Drosset disclosed a method to be executed by one or more processors for managing subscriber access to online subscription content comprising:

(a) providing the subscriber with access to the online subscription service at a first level of service during a subscription period (Drosset, col. 15, line 14, Drosset disclosed a user provided with a paying membership).

(b) after expiration of the subscription period, providing the subscriber with access to the online subscription service at a level of service that is lower than the first level of service during a post expiration period (Drosset, col. 15, lines 21-23, 45-65, Drosset disclosed that if payment is not received on the scheduled payment date then the users membership is downgraded to a non-paying membership).

Drosset did not explicitly state terminating subscriber access to the online subscription service after a specified post expiration period unless the subscription is renewed.

However, Drosset does in fact state that the user's information may be preserved for a period of time in the expectation that the account may be once again upgraded (Drosset, col. 15, lines 53-57). Therefore, Drosset disclosed that over a certain period of time, the status of data may transition into another category, and that data may be dropped.

Drosset did not explicitly state a termination category for subscriptions. However, as explicitly shown by Nye, after a certain period of time has elapsed, and the user has not renewed their subscription, the subscription is placed into a canceled subscriptions category (Nye, page 4, ¶ 46). Nye disclosed that "over time the status of the data that resides in one category transitions to another category, known as a state transition... For example the data held in the free trial subscribers category is moved to the canceled subscriptions category when a person lets their subscription run out..."

Both Drosset and Nye disclosed state transitions for member's subscriptions based on certain time periods and other conditions, such as payment. Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate the state transition of termination of a members subscriber access after a post expiration period for the purpose of allowing a developer to add complex dependency logic to an existing database without having to modify the underlying structure of the database (Nye, see Abstract), allowing an administrator of the subscription service to place renewed subscriptions and canceled subscriptions into different categories, allowing the administrator to perform separate actions on the accounts that users are still utilizing (Nye, page 4, ¶ 49).

Claims 33 and 48 include a computer program product with limitations that are substantially similar to those of claim 1. Therefore claim 33, and 48 are rejected under the same rationale as claim 1 as being substantially similar.

4. Regarding claim 2, Drosset and Nye disclosed the limitations substantially as claimed, as described in claim 1, including wherein the level of service is determined by a service parameter selected from download rate, portion of subscription content accessible, access to member-only features, color formatting, sound and combinations thereof (Drosset, col. 15, lines 47-65).

5. Regarding claims 3-5, Drosset and Nye disclosed the limitations, substantially as claimed, as described in claim 2, including gradually reducing the level of service during the post-expiration period (Drosset, col. 15, lines 45-55, Drosset disclosed incrementally reducing the level of service once), and notifying the user of any problems existing with their account (Drosset, col. 15, lines 29-58).

6. Regarding claim 6, Drosset and Nye disclosed the limitations, substantially as claimed, as described in claim 1, including allowing customers to renew their subscription at the paying membership level (Drosset, col. 15, lines 40-67).

7. Regarding claim 7, Drosset and Nye disclosed the limitations, substantially as claimed, as described in claim 6. Claim 7 is a reiteration of steps performed in claims 1 and 6, and is therefore rejected under the same rationale.

8. Regarding claim 9, Drosset and Nye disclosed the limitations, substantially as claimed, as described in claim 1, including notifying the customer of problems that need to be fixed for subscription renewal (Drosset, col. 15, lines 29-35).

9. Regarding claim 11, Drosset and Nye disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the subscriber is a potential new subscriber and wherein the subscription period is a trial subscription period (Nye, ¶ 46).

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include Nye's teaching of various states of customers' subscriptions with Drosset to not only provide specific promotions and offers (Nye, ¶ 44), but also to efficiently be able to determine the customer's state transitions from one state to another (Nye, ¶ 45).

10. Regarding claim 12, Drosset and Nye disclosed the limitations substantially as claimed, as described in claim 11, including wherein the level of service is determined by a service parameter selected from download rate, portion of subscription content accessible, access to member-only features, color formatting, sound and combinations thereof (Drosset, col. 15, lines 47-65).

11. Regarding claims 13-15, Drosset and Nye disclosed the limitations substantially as claimed as described in claims 1 and 11. Therefore claims 13-15 are rejected under the same rationale.

Claims 21, 22, 29, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drosset and Nye in view of Davis et al. (U.S. Pub. 2002/0040395).

12. Regarding claims 21, 29, and 46 Drosset and Nye disclosed a system with limitations that are substantially similar to those of claim 1, further including managing a subscriber's account through the use of a subscription service, subscription database, and a non-renewal database (Drosset, col. 2, lines 40-45).

Drosset did not explicitly disclose that the database contains post expiration access frequency.

However, in the same field of endeavor, Davis teaches a system for online subscription service (Davis, ¶ 32), which includes a database for recording client's activities, including frequency of accessing data from online provider (Davis, ¶ 9). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include Davis 's idea of tracking user's frequency of accessing online provider and commercialize targeting the particular user with Drosset for determining users' behavior after subscription period has expired. Because in doing so, the system

of Drosset would be able to accurately predict whether the particular subscribers would be interested in or could be induced to renew subscription.

13. Regarding claim 22, Drosset, Nye, and Davis disclosed the limitations substantially as claimed, as described in claim 21, including wherein the level of service is determined by a service parameter selected from download rate, portion of subscription content accessible, access to member-only features, color formatting, sound and combinations thereof (Drosset, col. 15, lines 47-65).

14. Claims 16-19, 23-28, 30-32, 34-40, 42-45, and 47 include limitations substantially similar to the limitations of claims 1-7, 9, 11-15, 21, 22, 29, 33, 46, and 48, and are therefore rejected under the same rationale as being substantially similar.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

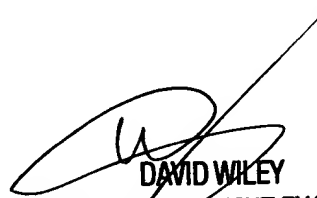
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Business Center (EBC) at 866-217-9197 (toll-free).



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